

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: YOUDIM=1.1A

In re Application of:	)	Conf. No.: 4865
	)	
Moussa YOUDIM et al	)	Art Unit: 1625
	)	
Appln. No.: 10/534,357	)	Examiner: Z. N. Davis
	)	
I.A. Filed: 11/07/2003	)	Washington, D.C.
371(c) 02/21/2006	)	
	)	
For: NEUROPROTECTIVE IRON	)	January 14, 2009
CHELATORS AND ...	)	

REPLY TO RESTRICTION AND  
ELECTION OF SPECIES OFFICE ACTION

Honorable Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop Amendment  
Randolph Building, 401 Dulany Street  
Alexandria, VA 22314

Sir:

In reply to the Office Action mailed June 11, 2009, applicants hereby respectfully and provisionally elect Group I, presently claims 1-60, 79-94, 96-134, 136 and 138-140, with traverse and without prejudice.

Applicants traverse because they disagree with the examiner's conclusion that the thirteen (13) designated groups lack the same or corresponding special technical feature.

Thus, the claims presently pending in the instant application define compounds, compositions comprising such compounds, and methods of treatment based on the utilization of such active compounds. These are all aspects of the same

invention which fully comply with PCT Rules 13.1 and 13.2 as regards unity of invention, because all such claims share a single general inventive concept and have a common technical relationship involving the same special technical feature. Such technical feature is not a common backbone shared with other known compounds as set forth in the Office Action, but is instead a structure and function common among the thirteen (13) groups, namely the provision of multi-functional compounds all of which comprise an iron chelation function, a residue which impart neuroprotection function and optionally further imparts an antiapoptotic function.

Thus, the shared single general inventive concept having a common technical relationship involves multi-functional compounds able, due to the particular common structures, to practice a combined therapy methodology comprising, simultaneously, iron chelation therapy, neuroprotection and optionally apoptosis inhibition.

Withdrawal of the requirement and examination of all the claims on the merits is warranted.

In addition to the restriction requirement, the PTO has also required an election of species. Accordingly, applicants hereby respectfully and provisionally elect compound M30 as the elected species, again with traverse and

without prejudice. The claims which read on the elected species are claims 1-5, 7-23, 38, 44, 52, 59, 60, 99-101 and 109, of which claims 1-5, 7, 8, 11, 12, 16-19, 38, 44, 60 and 109 are generic.

Applicants do not see that PCT Rules 13.1 and 13.2 justify the election of species requirement, and this is so for the same reasons as expressed above with respect to the restriction requirement. Thus, applicants do not see that the first reason for the requirement given in paragraph 8 on page 5 is valid for a National Phase PCT application.

As regards the second reason (serious search and examination burden), applicants believe and respectfully submit that the existence of a serious burden is not license for a restriction or election of species, as the PCT Rules 13.1 and 13.2 apply in the present case, and unity of invention exists. Nevertheless, the second paragraph of MPEP 803 authorizes the examination of plural inventions when restriction or election of species is proper (not the situation in the present case) if a serious burden does not exist. So the second paragraph of MPEP 803 would not come into play in this case at all unless the restriction and election of species were to be maintained.

In this latter regard, applicants admit that there are many claims, and the examination of additional claims

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might indeed add some additional burden. But considering the similarity of the various active compounds, applicants believe and respectfully submit that the added burden would not be serious. Moreover, as regards the search, no serious burden has been demonstrated.

Withdrawal of the election of species requirement is also respectfully requested.

Applicants respectfully request favorable consideration, and respectfully await the results of a first examination on the merits.

Respectfully submitted,

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